



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/560,397

04/28/2000

Stephen K. Boyer

01-063

4303

20306

7590

05/26/2004

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER

WOO, ISAAC M

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/560,397

Applicant(s)

BOYER ET AL.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-14, 17-23, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-14, 17, 19-23 and 26 is/are rejected.
- 7) ☒ Claim(s) 9, 18 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to Applicant's Arguments, filed on March 24, 2004 have been considered but they are not persuasive. Claims 1-5, 8-14, 17-23 and 26-27 are pending.

### ***Response to Amendment***

2. In response to Applicant's remarks filed on filed on March 24, 2004, the following factual argument points are noted: Yamamoto does not disclose or suggest that ranking assignee according to all patents held by assignee.

Examiner does not agree. Yamonaco discloses the DIALOG, searching patent database system, patent citation searching, RANK command to provide remaining patent assignees with the order of raking number, see page 6-8. This teaches that the DIALOG can extract assignee's rank. Therefore, it would have been obvious to a person having ordinary skill in the art the time of the invention was made to include organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for that assignee than for other assignees in the system of Rivetts to provide assignees ranking criteria, which provides data list with specific order and user-friend display.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8, 10-14, 17, 19-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751, hereinafter, "Rivette") in view of Lisa Yamonaco, Bonnie Arnwine, Seminar Development Team (DIALOG Patent Seminar, from Knight Ridder Information Inc. Strategic Training and Development, 1995), hereinafter, Yamonaco.

With respect to claims 1, 10 and 19, Rivette discloses the method, computer program and system for determining potential licensees for a source patent portfolio comprising one or more patents, devising a set of associated patents wherein each patent in the set of associated patents i) cites as reference a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 86-90, and col. 89, lines 15-53) or ii) is cited as reference by a patent in the source patent portfolio (backward reference, col. 4, lines 13-21, FIG. 86-90, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73); processing all of the patents in the set of associated patents to

establish a set of assignees contained in the set of associated patents (by assignees searching), see FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65.

Rivette discloses establishing a set of remaining assignees by removing from the set of assignees all assignee that are currently licensed, see fig. 104, col. 102, lines 7-67, the system of Rivette can extract licensed assignee, furthermore, it can extract unlicensed assignees from the patent database, assignee's patents in the set of associated patents, all patents held by assignee, see fig. 104, col. 102, lines 7-67.

Rivette does not explicitly disclose organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for that assignee than for other assignees.

However, Yamonaco discloses the DIALOG, searching patent database system, patent citation searching, RANK command to provide remaining patent assignees with the order of raking number, see page 6-8. The DIALOG can extract assignee's rank (sorting by ranking) by using RANK command. Therefore, it would have been obvious to a person having ordinary skill in the art the time of the invention was made to include organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for that assignee than for other assignees in the system of Rivetts to provide assignees ranking criteria, which provides data list with specific order and user-friend display. RANK command lists data with sorting order. Thus, displaying data with sorting provides user-friendly data manipulation in the database system.

With respect to claim 2, 11 and 20, Rivette discloses the adding, to the set of associated patents, patents that cite as a reference patents in the original set of associated patents (forward, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) or patents that are cited as a reference by a patent in the original set of associated patents, see backward, col. 4, lines 13-21, FIG. 86, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73.

With respect to claims 3, 12 and 21, Rivette discloses the determining a set of cited references contained in the patents of the source patent portfolio (forwarding references and backward references); adding, to the set of associated patents, patents that contain at least one of the references found in the set of cited references (reference cited), see col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53; col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73.

With respect to claims 4, 13 and 22, Rivette disclose that the source portfolio (forwarding references) is the set of all patents assigned to a particular assignee, see FIG. 53, col. 28, lines 1-51.

With respect to claims 5, 14 and 23, Rivette disclose that presenting the organized assignees in an HTML document that can be read by an Internet browser, see FIG. 53, col. 10, lines 30-54, col. 28, lines 1-51 and col. 38, lines 25-67 to col. 39, lines 1-13.

With respect to claims 8, 17 and 26, Rivette discloses that the ranking criteria gives more weight to assignees having patents that have commonly cited references with patents in the source patent portfolio, see col. 103, lines 25-67 to col. 104, lines 1-45.

***Allowable Subject Matter***

5. Claims 9, 18 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

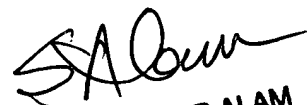
***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW  
May 17, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER